

THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

In re application of: Bishwajit Nag, et al.

Attorney Docket No.: BEX1P004

Application No.: 10/681,827

Examiner: Cordero Garcia, M. M.

Filed: October 7, 2003

Group: 1654

Title: DIPEPTIDE PHENYL ETHERS

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first-class mail on January 18, 2006 in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Signed: _____

Valerie Olsen

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Remarks begin on page 2 of this paper.

REMARKS

The examiner has indicated in the Advisory Action of December 8, 2005 that Applicants' amendment after final of November 21, 2005 will be entered upon filing an appeal. Upon entry of that amendment, the only issue remaining in the case is the rejection under 35 U.S.C. 112, second paragraph, in the use of the term "analog" in the claims. The examiner's reason for maintaining this rejection is that the term "analog" is not defined by Applicants in a closed definition within the specification.

The term "analog" used in the specification, at page 12, lines 10-11, is the conventional definition:

The term "analog" refers to a set of compounds which differ from one another only by replacement of one or more heteroatoms, such as O, S, or N, with a different heteroatom.

In the final rejection, the examiner cites a definition of the term "analog" from Answers.com. The definition is attached to the final rejection. In the third definition applicable to chemistry, the Answers.com definition is as follows:

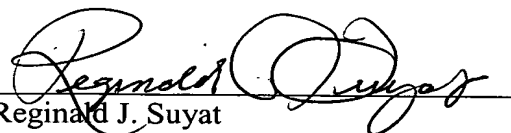
A structural derivative of a parent compound that often differs from it by a single element.

Applicants' definition in the specification is not inconsistent with the definition cited by the examiner in Answers.com, and indeed Applicants' definition is narrower in that it is restricted to replacement only of heteroatoms with other heteroatoms. It is clear that Applicants' definition is a closed definition, since the analogs of the compounds recited in the claims can only differ from structures recited in the claims by replacement of one or more of the heteroatoms with different heteroatoms.

It is submitted that Applicants' definition provided in the specification is a closed definition and complies with 35 U.S.C. 112, second paragraph.

Dated: January 18, 2006

Respectfully submitted,
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